

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

MAY 24 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES F. McGUCKIN JR.

Appeal No. 2006-1714
Application No. 09/697,306

ON BRIEF

Before KIMLIN, GARRIS, AND WALTZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 36-48.

Claims 49-51, the other claims remaining in the present application, have been allowed by the examiner. Claim 36 is illustrative:

36. An apparatus for resecting tissue within a body lumen, comprising:

an operating capsule including a coupling structure for selectively coupling to a flexible endoscope, the operating capsule being sized so that, when in an operative position entirely located within a body lumen adjacent to a selected

Appeal No. 2006-1714
Application No. 09/697,306

portion of tissue to be resected structural integrity of luminal tissue is maintained, the operating capsule including a suturing assembly and defining a cutting zone adjacent to the suturing assembly;

a flexible member extending proximally from the operating capsule to a control handle, wherein, when the operating capsule is in an operative position within a body lumen, the flexible member extends through the body and out a natural body orifice to the control handle; and

a tissue grabber grasping a full thickness fold of tissue including the selected portion of tissue and drawing the grasped fold of tissue into the cutting zone, wherein the suturing assembly fastens abutting portions of the grasped fold of tissue.

In the rejection of claims on appeal, the examiner relies upon the following references:

Tsuruta et al. (Tsuruta)	5,389,098	Feb. 14, 1995
Kuramoto et al. (Kuramoto)	5,395,030	Mar. 7, 1995
Sauer et al. (Sauer)	5,562,694	Oct. 8, 1996
Kessel (German Patent)	DE 4,006,673	Sep. 5, 1991

Appellant's claimed invention is directed to an apparatus for resecting tissue within a body lumen. The apparatus comprises an operating capsule that is sized to be located within a body lumen and which is coupled to a flexible endoscope. The operating capsule includes a suturing assembly and defines a cutting zone adjacent to the suturing assembly for

Appeal No. 2006-1714
Application No. 09/697,306

a selected portion of tissue that is to be resected. The apparatus also comprises a flexible member that extends from the operating capsule and out a natural orifice of the body.

Appealed claims 36-38, 40-44 and 46-48 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kuramoto. Claims 36-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuruta in view of Sauer and Kessel.

Appellant submits at page 2 of the Supplemental Reply Brief that claims 36-43 stand or fall together, as do claims 44-48.

We have thoroughly reviewed the respective positions advanced by appellant and the examiner. In so doing, we find that the examiner's § 102 rejection is well-founded and in accord with current patent jurisprudence. However, we concur with appellant that the examiner's § 103 rejection is not sustainable.

For the reasons set forth by the examiner in the Answer and Supplemental Answer, which we incorporate herein, we find that Kuramoto describes the subject matter defined by independent claims 36 and 44 within the meaning of § 102. There is no dispute that Kuramoto does not teach that forceps 150 act as a tissue grabber, as presently claimed. However, the examiner properly explains that it is only necessary that the forceps of

Appeal No. 2006-1714
Application No. 09/697,306

the reference be capable of performing the claimed function of grabbing tissue and drawing it into the cutting zone of the reference device, as explained at page 5 of the Examiner's Supplemental Answer. Figures 22 and 23 of Kuramoto indicate that at some point in time between the operations shown in the pictures, "the anvil shaft 147 would not have yet penetrated the fold of tissue at 114" (page 5 of Supplemental Answer). During this period of time, we concur with the examiner that the device of Kuramoto would be capable of extending the forceps to grasp section 114 of the tissue and draw it into a position between member 138 and a position where anvil 146 will pierce through tissue 114. We further agree with the examiner that "[t]he forceps could even be used to assist in holding the tissue still while the anvil pin 147 pierced through tissue 114" (id.). In addition, since Figure 25 of Kuramoto illustrates that forceps 150 can be moved laterally, the forceps can be aligned away from the axis of anvil shaft 147 whereby the forceps can "grasp another section of tissue, pull it over the pin and even cause the pin to puncture the new tissue, followed by using the forceps to grasp the pin 147 and draw the pin to the stapler [and] . . . into the cutting zone" (id.).

Appellant argues that "Kuramoto does not disclose or suggest grasping tissue using the forceps 150, and certainly never discloses grasping and pulling tissue with enough force to pierce the tissue" (page 4 of Supplemental Reply Brief, first paragraph). As noted above, the examiner appreciates that the reference provides no such teaching or suggestion. However, it is our view that appellant has not refuted the examiner's rationale that the device of Kuramoto is capable of performing the claimed function. While appellant maintains that Kuramoto does not teach "any control mechanism or steering apparatus which would allow the type of maneuvering required to position the forceps 150 adjacent to the tissue 114" (id.), we agree with the examiner that tube 136 of the reference is capable of being moved to guide the forceps to the required positions. Also, notwithstanding appellant's arguments to the contrary, we agree with the examiner that the broadly claimed "cutting zone" is met by the area of Kuramoto adjacent to the cutter wherein the tissue would be drawn by the forceps.

We now turn to the examiner's § 103 rejection. The appealed claims define an apparatus that is capable of resecting tissue within a body lumen comprising an operating capsule that is sized to be located within a body lumen. As recognized by

Appeal No. 2006-1714
Application No. 09/697,306

the examiner, the device of Tsuruta is not meant to operate within a body lumen but, rather, the device of the reference is inserted into a body cavity through an incision. Indeed, neither Tsuruta, nor Sauer nor Kessel, which the examiner relies upon for modifying the device of Tsuruta, is designed to operate within a body lumen. Accordingly, we cannot subscribe to the examiner's position that it would have been obvious for one of ordinary skill in the art to modify the device of Tsuruta to arrive at the claimed device that is sized to function within a body lumen. The examiner's statement that the device of Tsuruta "certainly could have been used in, or through a body orifice" misses the point (page 6 of Supplemental Answer, third paragraph). Even if the apparatus of Tsuruta could be inserted in a body orifice, such as the mouth or anus, this is a far cry from being capable of functioning in the claimed manner in the more restricted area of a body lumen.

In conclusion, the examiner's rejection under § 102 is sustained, whereas the examiner's rejection under § 103 is reversed. Accordingly, the examiner's decision rejecting the appealed claims is affirmed-in-part.

Appeal No. 2006-1714
Application No. 09/697,306

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED-IN-PART

Edward C. Kimlin

EDWARD C. KIMLIN)
Administrative Patent Judge)
)

Bradley R. Garris

BRADLEY R. GARRIS) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)

Thomas A. Waltz

THOMAS A. WALTZ)
Administrative Patent Judge)

ECK:clm

Appeal No. 2006-1714
Application No. 09/697,306

Fay, Kaplun & Marcin, LLP
150 Broadway, Suite 702
New York, NY 10038